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PATENT

Attorney Docket Nos. 084/US/PCT2/US and 00537-188002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE-----
IN RE APPLICATION OF:

GORDON, Thomas D. et al.

APPLICATION NO.: 09/868,356

FILED: August 10, 2001

FOR: PRENYL TRANSFERASE INHIBITORS
-----Commissioner of Patents
Alexandria, VA 22313-1450

EXAMINER: Coleman, Brenda Libby

ART UNIT: 1624

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Assistant Commissioner of Patents, Washington, D.C. 20231.
Date of Deposit: May 13, 2003

Alan F. Feeney

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Action mailed November 13, 2002 (Paper No. 7) (hereinafter "the instant action"), the Applicant respectfully requests consideration of the following remarks and reconsideration of the restriction delineated in the instant Action.

In the instant action, claims 1-19 are listed as pending and all are listed as subject to a restriction requirement.

This above application is a national stage application under 35 U.S.C. 371 of PCT International Application PCT/US99/31302. As such, unity of invention, rather than restriction, practice is applicable. See MPEP §§1893.03(d) and 1895.01 I. D. Rule 13 (Unity of Invention) of the Regulations under the PCT states that the requirement of unity is fulfilled when "there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." See Rule 13.2, Regulations under the PCT. Unity of Invention practice is also governed by MPEP §1893.03(d), which states in part:

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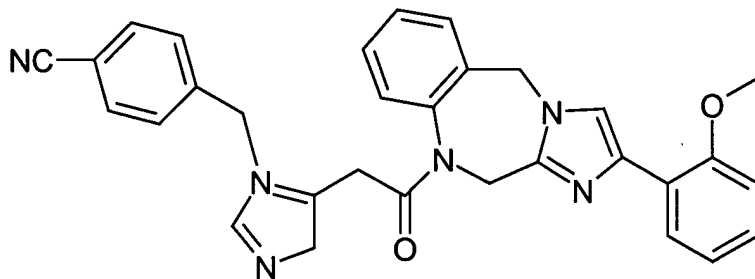
*When making a lack of unity of invention requirement, the examiner **must** (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.*
(Emphasis added) See MPEP §1893.03(d).

While understanding that the Unity of Invention determinations made for the Preliminary Search Report and the Preliminary Examination Report are not binding on the present Examiner, and that Unity of Invention is determined under the auspices of PCT Rule 13, Applicant notes, however, that the International Preliminary Examining Authority did not find that the claims lacked "a single general inventive concept under PCT Rule 13.1." In the instant Action, no indication is given as to the reasoning behind the allegation of lack of unity of each group with the others of Groups I-IV. Such reasoning, as stated previously, is required under MPEP §1893.03(d). Merely identifying that the above application consists of more than one invention does not necessarily warrant a finding of "lack of unity" since an applicant has "the right to include in a single application" more than one invention so long as the claimed inventions "are so linked as to form a single general inventive concept." See MPEP §1893.03(d). No art is cited in support of allocation of the claims to the alleged distinct inventions. As such, Applicant submits that each of the combinations of groups delineated by the Examiner meet the criterion of relating to a single inventive concept. Each combination of groups has a technical relationship that involves at least one common or corresponding technical feature. Such features define the contribution, considered as a whole, that the invention makes over the prior art.

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For the foregoing reasons, Applicant submits that the restriction made in the instant action was improper and respectfully requests reconsideration of that restriction and a delineation of reasoned support for distinguishing each group ultimately determined as lacking unity with each other group, as required under MPEP §1893.03(d).

In compliance with 37 C.F.R. §1.143, Applicant elects the invention of Group I drawn to compounds, compositions and method of use of the compounds of formula I, where $n = 1$, and formula I forms an imidazobenzodiazepine ring, and elects Compound 23, i.e., 1-(2-(1-(4-cyanophenylmethyl)imidazol-4-yl)-1-oxoethyl)-1,2-dihydro-4-(2-methoxyphenyl)-imidazo[1,2-c][1,4]benzodiazepine, having the structure,



as Applicant's species within Group I. The election is made with traverse.

In response to the Examiner's directive to provide a substitute specification, including the claims, as required under 37 C.F.R. 1.125(a), Applicant submits a complete copy of international application PCT/US99/31302. The above application is the U.S. national phase under 35 U.S.C. 371 of said international application.

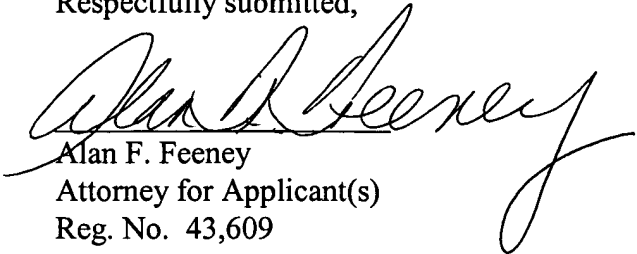
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Date: 5/13/2003

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Respectfully submitted,


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